

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:	Juha KALLIO	Confirmation No.:	5666
Application No.:	10/517,442	Examiner:	Mehrpour, Naghmeh
Filed:	December 23, 2004	Group Art Unit:	2617

For: DOWNLOADABLE PROFILES FOR MOBILE TERMINALS

APPEAL BRIEF

Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

This Appeal Brief is submitted in support of the Notice of Appeal dated May 14, 2008.

I. REAL PARTY IN INTEREST

NOKIA CORPORATION is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals and interferences.

III. STATUS OF THE CLAIMS

Claims 28 through 58 are pending in this appeal, in which claims 1 through 27 are canceled.

No claim is allowed. This appeal is therefore taken from the final rejection of claims 28 through 58 on January 14, 2008.

IV. STATUS OF AMENDMENTS

The amendment to claims 28, 41, 54, and 58 and the cancellation of claims 32, 45, and 55, filed April 4, 2008 have not been entered and are not relied upon in this appeal. Accordingly, claims 28 through 58, as they existed at the time of the amendment filed December 5, 2007, are pending and are on appeal.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The claimed invention addresses problems associated with downloadable profiles for mobile terminals. In particular, customization of mobile terminals is improved by providing improved profile information to the mobile terminals.

Independent claim 28 provides for the following:

28. A method, comprising:

determining profile reception capabilities of a mobile terminal (See, e.g., Specification, page 2,

lines 15-18; page 5, lines 5, 6; page 7, lines 19 through 27; Fig. 1, element 104);

allocating a profile to a specific event (See, e.g., Specification, page 2, lines 15-18);

detecting an association of the mobile terminal with said event (See, e.g., Specification, page 2,

lines 15-18); and

based on the determining, transmitting said profile to said mobile terminal (See, e.g., Specification, page 2, lines 15-18).

Independent claim 41 provides for the following:

41. An apparatus, comprising:

a determining server configured to determine profile reception capabilities of a mobile terminal (See, e.g., Specification, page 3, lines 8-14; page 5, lines 5, 6; page 7, lines 19 through 27; Fig. 1, 2, element 104);

a first communications interface configured to provide a mobile network with event specific information (See, e.g., Specification, page 3, lines 8 through 14; page 5, lines 6, 7; Fig. 1, 2, element 106);

a second communications interface configured to receive details of the mobile terminal associated with said event specific information (See, e.g., Specification, page 3, lines 8 through 14; page 5, lines 6, 7; Fig. 1, 2, element 108); and

a third communications interface configured to transmit the event specific profile to the mobile terminal associated with an event specific information (See, e.g., Specification, page 3, lines 8 through 14; page 5, lines 6, 7; Fig. 1, 2, element 110).

Independent claim 54 provides for the following:

54. A system, comprising:

an application server associated with an event configured to determine profile reception capabilities of a mobile terminal (See, e.g., Specification, page 3, line 24 through page 4, line 5; page 5, lines 5, 6; page 6, line 3 through page 8, line 8; Fig. 1, 2, element 104);

a mobile communication network configured to receive event specific characteristics from the application server (See, e.g., Specification, page 3, line 24 through page 4, line 5; page 5, lines 5, and 16 through 21; page 6, line 3 through page 8, line 8; Fig. 1, 2, element 100);

and

at least one mobile terminal configured to connect to said network (See, e.g., Specification, page 3, line 24 through page 4, line 5; page 5, line 6; page 6, line 3 through page 8, line 8; Fig. 1, 2, element 122),

wherein the mobile network notifies the application server if the mobile terminal is associated with said event, and when responsive thereto the application server transmits the event specific profile to said mobile terminal (See, e.g., Specification, page 3, line 24 through page 4, line 5; page 5, lines 16 through 26; page 6, line 3 through page 8, line 8; Fig. 2).

Dependent claim 55 provides for the following:

55. The method of claim 28, wherein the determining profile reception capabilities comprises determining the capability of the mobile terminal to install a particular profile (See, e.g., Specification, page 7, lines 13 through 18; page 7, line 28 through page 8, line 8).

Dependent claim 57 provides for the following:

57. The system of claim 54, wherein the application server is further configured to determine the capability of the mobile terminal to at least one of receiving a particular profile, and installing a particular profile (See, e.g., Specification, page 7, lines 13 through 18; page 7, line 28 through page 8, line 8).

Independent claim 58 provides for the following:

58. An apparatus, comprising:

determining means for determining profile reception capabilities of a mobile terminal;

first communications interface means for providing a mobile network with event specific information (See, e.g., Specification, page 5, lines 6, 7; Fig. 1, element 106);

second communications interface means for receiving details of the mobile terminal associated with said event specific information (See, e.g., Specification, page 5, lines 6, 7; Fig. 1, element 108); and

third communications interface means for transmitting the event specific profile to the mobile terminal associated with an event specific information (See, e.g., Specification, page 5, lines 6, 7; Fig. 1, element 110).

VI. **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Whether claims 28 through 52 and 54 through 58 are anticipated under 35 U.S.C § 102(e) by *Brescia* (US 7,068,189)?

Whether claim 53 is obvious under 35 U.S.C. § 103 based on *Brescia* (US 7,068,189) in view of *Murto et al.* (US 7,249,100)?

VII. **ARGUMENT**

A. **CLAIMS 28 THROUGH 52 AND 54 THROUGH 58 ARE NOT ANTICIPATED OVER *BRESCIA*, BECAUSE *BRESCIA* FAILS TO DISCLOSE THE TRANSMISSION OF A PROFILE TO A MOBILE TERMINAL.**

To anticipate a patent claim, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Brescia generally describes delivering information, such as a notification or other content, to a select communication device when defined event and location criteria are satisfied. A profile is established to define the event and location criteria along with a method for delivering the information. Specifically, *Brescia* states, for example, at col. 4, lines 46 through 50, "[e]ach profile will typically define information to provide to a select device when predefined event and location indicia are satisfied. The information provided to the user may be a simple notification, pre-selected content, or a combination thereof." Thus, the device in *Brescia* does not receive a profile that is transmitted from an application server. Rather, in *Brescia*, the **profile is stored on an application server**, and **only certain information**, i.e., event and location criteria, not the profile, is transmitted to the mobile terminals. The "profile" is sent to an application server and not to a mobile terminal in *Brescia*. Further, the "information" that is sent to a select device, e.g., a mobile terminal, such as a notification or other content, is not a "profile" as defined in the present claimed invention. It is noted, for the convenience of the Honorable Board, that "profile" in the instant application has a very specific meaning, i.e., "collections of user settings or preferences that the end user can automatically manage together" (See, e.g., Specification, page 1, lines 18, 19). Thus, in accordance with the teachings of *Brescia*, it is only the resulting information (if a match occurs), and **not a profile**, that is sent to a device. The "information" sent to the user device in *Brescia* is a "simple notification, preselected-content, or a combination thereof" (column 4 lines 48-50). The "information" does not constitute a "profile," as claimed. Therefore, *Brescia* cannot anticipate the subject matter of independent claims 28, 41, 54, and 58, or that of claims 29 through 40, 42 through 52, and 55 through 57, dependent thereon.

In summary, it is respectfully submitted that *Brescia* fails to disclose (or even to suggest, for that matter) at least the feature of "transmitting said profile to said mobile terminal," as recited in independent claim 28 and similarly recited in independent claims 41, 54, and 58. *Brescia* merely

discloses sending "information" to the appropriate device, if the event occurrence and location indicia match the event and location criteria. These deficiencies in *Brescia* constitute clear error on the part of the Examiner in rejecting claims 28 through 52 and 54 through 58 under 35 U.S.C § 102(e).

In the "Response to Arguments" section of the Final Office Action of January 14, 2008, the Examiner fairly describes the operation of *Brescia*. While the Examiner asserts that, in *Brescia*, a "profile is established to define the event and location criteria along with a method for delivering the information," it is noteworthy that the Examiner omits any reference to a teaching in *Brescia* about transmitting the profile to a device, or mobile terminal. The Examiner omits any such reference because there is no teaching or even a suggestion in *Brescia* of transmitting the profile, itself, to a mobile terminal. Only the **information**, which is **derived from the profile** in the application server, is transmitted to the mobile terminals, but the profile is not so transmitted.

Again, the claimed "profile" feature is clearly described in the specification, e.g., "collections of user settings or preferences that the end user can automatically manage together" (See, e.g., Specification, page 1, lines 18, 19). MPEP 2111.01 (IV) recites that "where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings"). In this case, the word "profile" is defined in the specification and it is defined in a manner as those skilled in the art would understand the term "profile."

Well-settled case law holds that the words of a claim must be read as they would be interpreted by those of ordinary skill in the art. *In re Baker Hughes Inc.*, 215 F.3d 1297, 55 USPQ2d 1149 (Fed. Cir. 2000); *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed.

Cir. 1997); M.P.E.P. 2111.01. "Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach." *In re Cortright*, 165 F.3d 1353, 1369, 49 USPQ2d 1464, 1465 (Fed. Cir. 1999). Therefore, the Examiner **must** accept Appellant's definition and construe the claimed "profile" as defined by Appellant, which, in this case, is also the meaning understood by those skilled in the art..

Further, the Examiner's explanation of the rejection reads features into *Brescia* that are neither disclosed nor suggested therein. For example, the Examiner's position appears to be that *Brescia* describes transmitting the profile to the mobile terminal rather than to an application server, but Appellant respectfully submits that this description is nowhere to be found in *Brescia*, and is an unreasonably broad interpretation of what is actually disclosed therein. Accordingly, the Examiner's rejection of claims 28 through 52 and 54 through 58 under 35 U.S.C § 102(e) is legally flawed.

Moreover, Appellant respectfully submits that *Brescia* fails to disclose or suggest at least the feature of "determining profile reception capabilities of a mobile terminal," as recited in claims 28, 41, 54, and 58. Appellant respectfully submits that *Brescia* is silent with regard to this feature. In *Brescia* the **information** is transmitted to the device **without a determination being made as to the device's capabilities**.

On page 2 of the Final Office Action, the Examiner took the position that column 3, lines 5-59, of *Brescia* describes "determining profile reception capabilities of a mobile terminal." However, the cited portion merely describes that the email server is capable of sending email to devices receiving email via the circuit-switched networks 14. *Brescia* does not disclose or suggest any determining **profile reception capabilities of a mobile terminal**. Thus, *Brescia* fails to disclose or suggest, at least, "determining profile reception capabilities of a mobile terminal," as recited in independent claims 28, 41, 54, and 58.

Based at least on the above, Appellant submits that *Brescia* fails to disclose or suggest all of the features recited in independent claims 28, 41, 54, and 58. Accordingly, Appellant respectfully submits that the rejection under 35 U.S.C. 102(e) is clearly erroneous and respectfully requests the Honorable Board to reverse the rejection of claims 28 through 52 and 54 through 58 under 35 U.S.C § 102(e).

CLAIMS 55 AND 57 ARE SEPARATELY PATENTABLE

Furthermore, *Brescia* is silent regarding the feature of determining the capabilities of the mobile terminal **to install a particular profile** as recited in claims 55 and 57. In the Final Office Action, the Examiner fails to cite any particular portion of *Brescia* alleged to disclose the feature of “wherein the determining profile reception capabilities comprises **determining the capability of the mobile terminal to install a particular profile**” recited in claim 55. As to the feature of “wherein the application server is further configured to **determine the capability of the mobile terminal to at least one of receiving a particular profile, and installing a particular profile**” of claim 57, the Examiner cites col. 1, lines 38 through 54, of *Brescia* as allegedly teaching this feature. Even a cursory inspection of the cited portion of the reference indicates that while a profile is established to define event and location criteria along with a method for delivering the information, i.e., “notification or other content,” and while, alternatively, a determination is made as to whether an event corresponding to the event criteria is satisfied after comparing a location with a location criteria, there is no disclosure, in any way, shape, or form, of determining, by an application server, **“the capability of the mobile terminal to at least one of receiving a particular profile, and installing a particular profile,”** as recited in claim 57.

These deficiencies in *Brescia* constitute clear error in the rejection. Thus, claims 55 and 57 are separately patentable and the Honorable Board is respectfully requested to reverse the rejection

of claims 55 and 57 under 35 U.S.C § 102(e) even if the rejection of independent claims 28 and 54 is affirmed.

Claims 29 through 40, 42 through 52, and 55 through 57 are dependent upon claims 28, 41, and 54. Accordingly, claims 29 through 40, 42 through 52, and 55 through 57 are allowable for at least their dependence upon independent claims 28, 41, and 54, and for the specific limitations recited therein.

The rejection of claims 28 through 52 and 54 through 58 must be reversed, because *Brescia* does not disclose the features of the claims.

B. CLAIM 53 IS NOT RENDERED OBVIOUS BY *BRESCIA* AND *MURTO ET AL.* BECAUSE *MURTO ET AL.* FAILS TO PROVIDE FOR THE DEFICIENCIES OF *BRESCIA*.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1451 (Fed. Cir. 1997); *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995); *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 357 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970).

Claim 53 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Brescia* in view of *Murto et al.*

Murto et al. generally describes a system and method for enabling a mobile phone or wireless PDA to discover Internet business and services by accessing the Universal Description, Discovery and integration (UDDI) registry using a user's location or coordinates. While *Murto et al.* does discuss Bluetooth technology and general radio packet interfaces, it does not cure the above-identified deficiencies in *Brescia*. Thus, Appellant respectfully submits that *Murto et al.* and *Brescia*, and the combination thereof, fail to disclose or suggest all of the elements of claim 41, from which claim 53 depends. These deficiencies in *Murto et al.* and *Brescia* constitute clear error in the rejection.

The rejection of claim 53 must be reversed, because the combination of *Brescia* and *Murto et al.* does not establish a *prima facie* case of obviousness with regard to the instant claimed subject matter.

VIII. CONCLUSION AND PRAYER FOR RELIEF

For the foregoing reasons, Appellant requests the Honorable Board to reverse each of the Examiner's rejections.

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

May 26, 2009

Date

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IX. CLAIMS APPENDIX

Claims 1-27. (Cancelled)

28. A method, comprising:

determining profile reception capabilities of a mobile terminal;

allocating a profile to a specific event;

detecting an association of the mobile terminal with said event; and

based on the determining, transmitting said profile to said mobile terminal.

29. A method according to claim 28, wherein said profile includes a collection of user settings or preferences.

30. A method according to claim 28, wherein said profile includes user manageable settings.

31. A method according to claim 28, wherein said profile includes a custom or event specific profile package.

32. A method according to claim 28, further comprising:

installing the profile in said mobile station.

33. A method according to claim 28, wherein said event is a location dependent event, and wherein detecting an association of a mobile terminal with said event comprises detecting a location of the mobile terminal.

34. A method according to claim 33, wherein said event is further a time dependent event, and detecting an association of a mobile terminal with said event further comprises detecting the location of the mobile terminal within a predetermined time period.

35. A method according to claim 34, wherein the predetermined time period corresponds to duration of the event.

36. A method according to claim 28, further comprising: removing said profile from said mobile terminal responsive to termination of said event.

37. A method according to claim 36, wherein said removing comprises transmitting a termination signal to said mobile terminal responsive to which said profile is deleted.

38. A method according to claim 37, wherein the profile is removed responsive to the mobile terminal leaving the location associated with an event.

39. A method according to claim 28 wherein the profile includes a link to event specific information.

40. A method according to claim 28 wherein the profile includes the identity of an instant community.

41. An apparatus, comprising:

a determining server configured to determine profile reception capabilities of a mobile terminal;

a first communications interface configured to provide a mobile network with event specific information;

a second communications interface configured to receive details of the mobile terminal associated with said event specific information; and

a third communications interface configured to transmit the event specific profile to the mobile terminal associated with an event specific information.

42. An apparatus according to claim 41, wherein said profile includes a collection of user settings or preferences.

43. An apparatus according to claim 41, wherein said profile includes user manageable settings.

44. An apparatus according to claim 41, wherein said profile includes a custom or event specific profile package.

45. An apparatus according to claim 41, further including installing the profile in said mobile station.

46. An apparatus according to claim 41, wherein the event is a location dependent event.

47. An apparatus according to claim 41 wherein the event is further a time dependent event.

48. An apparatus according to claim 41, wherein the event specific information is a geographical location.

49. An apparatus according to claim 41, wherein the second communications interface receives details of a mobile terminal located in said location.

50. An apparatus according to claim 49, wherein said details include the identity of the mobile terminal.

51. An apparatus according to claim 41, wherein the first and second communications interface are a fixed line communication interface.

52. An apparatus according to claim 41, wherein the third communication interface is a mobile wireless communication interface.

53. An apparatus according to claim 52, wherein the third communication interface is a general packet radio service or Bluetooth interface.

54. A system, comprising:

an application server associated with an event configured to determine profile reception capabilities of a mobile terminal;

a mobile communication network configured to receive event specific characteristics from the application server; and

at least one mobile terminal configured to connect to said network,

wherein the mobile network notifies the application server if the mobile terminal is associated with said event, and when responsive thereto the application server transmits the event specific profile to said mobile terminal.

55. The method of claim 28, wherein the determining profile reception capabilities comprises determining the capability of the mobile terminal to install a particular profile.

56. The apparatus of claim 41, wherein the determining server is further configured to determine the capability of the mobile terminal to at least one of receiving a particular profile, and installing a particular profile.

57. The system of claim 54, wherein the application server is further configured to determine the capability of the mobile terminal to at least one of receiving a particular profile, and installing a particular profile.

58. An apparatus, comprising:

determining means for determining profile reception capabilities of a mobile terminal;

first communications interface means for providing a mobile network with event specific information;

second communications interface means for receiving details of the mobile terminal associated with said event specific information; and

third communications interface means for transmitting the event specific profile to the mobile terminal associated with an event specific information.

X. EVIDENCE APPENDIX

Appellants are unaware of any evidence that is required to be submitted in the present Evidence Appendix.

XI. RELATED PROCEEDINGS APPENDIX

Appellants are unaware of any related proceedings that are required to be submitted in the present Related Proceedings Appendix.